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09/776,629	02/06/2001	Yoshio Sugimoto	1046.1238 (JDH)	7168
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STAAS & HALSEY LLP			BARQADLE, YASIN M	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			2153	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/776,629

Applicant(s)

SUGIMOTO, YOSHIO

Examiner

Yasin M. Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2007 has been entered.

**Response to Amendment**

2. The amendment filed on October 17, 2007 has been fully considered but are not persuasive.

- Claims 1-22 are presented for examination.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention

Claims 1,8,15 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "wherein the list of electronic mail in the created unread mail list is unchanged until a later second time even if an already-read condition of an electronic mail in the created unread mail list is fulfilled before the later second time". The Applicant points out page 11, lines 6-7 and page 30, lines 9-13 to support this limitation. For example, page 11, lines 6-7 recites "" Further, the managing module 7A creates the unread mail list 16 at a predetermined timing.", where page 30, lines 9-13 recites "The contents of the unread mail list 16 do not change due to a fulfillment of the already-read setting condition (the display of the body of the electronic mail), and the unread mail list 16 continues to be effective till the viewer window 15A is closed (disappear from the screen)."

There is a major difference between what is taught in above portions and what is recited in claims "wherein the list of electronic mail in the created unread mail list is unchanged until a later second time even if an already-read condition of an electronic mail in the created unread mail list is fulfilled before the later second time."

The above portion merely teaches "The contents of the unread mail list 16 do not change due 10 to a fulfillment of the already-read setting condition (the display of the body of the electronic mail), and the unread mail list 16 continues to be effective till the viewer window 15A is closed (disappear from the screen). Examiner interprets the display of body the electronic mail as viewing the body of unread mail and not opening.

#### **Response to Arguments**

The Applicant in essence argues "Bailey does not teach, for example, a device including a list of electronic mail in the created unread mail list is unchanged until a later second time even if an already-read condition of an electronic mail in the

created unread mail list is fulfilled before the later second time, as recited by claims 1, 8, and 15". Examiner interprets the display of body the electronic mail as taught by Bailey's meets the above limitation Bailey teaches "if the displayed message does not fit in the preview pane entirely (such as partial display of the message step 82) the flag remains FALSE (the state remains unread) (col. 5, lines 54-60).

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al USPN (5835084).

As per claim 1, Bailey et al teach a device for reading electronic mails (device 10, fig. 2), comprising:

a storing unit storing unread/already-read information corresponding to each of received electronic mails [storage 34, stores received unread email messages addressed (received) to a user col. 3, lines 60-67 and col. 4, lines 33-56];

a managing module creating an unread mail list consisting a list of electronic mail that was unread at a certain first time based on the unread/already-read information (a list of unread messages are displayed visually different than the read messages (abstract), and upon reading one of the electronic mails after a predetermined timing [window pane hold a list of unread/already-read message. Email messages are organized and mark as read or unread col. 3, lines 60-67; col. 4, lines 45-52

and col. 5, lines 10-32], wherein the list of electronic mail in the created unread mail list is unchanged until a later second time even if an already-read condition of an electronic mail in the created unread mail list is fulfilled before the later second time". (a timer is set for a selected time-out period and if the entire message is not displayed keeping the flag false col. 5, lines 54-65 and col. 6, lines 21-38); and

a controller controlling a management of reading of the electronic mail contained in the created unread mail list [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-65 and col. 6, lines 21-38].

As per claim 2, Bailey et al teach the device according to claim 1, wherein said storing unit stores the state of "unread" or a state of "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-23]; and

said controller executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [col. 3, lines 60 to col. 4, line 56 and col. 5, lines 1-14].



As per claim 3, Bailey et al teach the device according to claim 2, wherein said controller specifies the electronic mail with the state of "unread" on the list corresponding to the request by use of said list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claim 4, Bailey et al teach the device according to claim 1, further comprising a display controller displaying a screen for searching the electronic mail with the state of "unread" on the list managed by said managing module on said display [fig. 3; col. 3, lines 60 to col. 4, lines 7 and col. 5, lines 1-23].

As per claim 5, Bailey et al teach the device according to claim 4, wherein said list holds information of the plurality of registered electronic mails in predetermined sort order [fig. 3, col. 4, lines 33-44];

a pointer is set at any one of the information in said list [fig. 3, and col. 4, lines 45-52]; and

said display controller displays the screen for searching an electronic mail registered next to the registered electronic mail corresponding to the information pointed by the pointer and/or a previous electronic mail of the registered electronic

mail corresponding to the information pointed by the pointer [fig. 3, and col. 4, lines 45-52 and col. 6, lines 21-26].

As per claim 6, Bailey et al teach the device according to claim 1, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

As per claims 8, 15 and 22, these are a storage medium and method claims with similar limitations as claim 1 above.

Therefore, they are rejected with the same rationale. See the rejection of Claim 1 above.

As per claims 9 and 16, Bailey et al teach the invention wherein said storing stores the state of "unread" or a state "already-read" of a corresponding electronic mail as the unread/already-read information [col. 5, lines 10-32],

said controlling step executes a process for displaying a registered electronic mail in said list on a display according to a request for reading the registered electronic mail [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-38].

As per claims 10 and 17, Bailey et al teach the invention wherein said controlling specifies the electronic mail with state of "unread" corresponding to the request by use of said list, and displays a body of the specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claims 11 and 18, Bailey et al teach the invention, further comprising displaying a screen for searching the electronic mail with the state of "unread" on said display [A list of unread/already ready messages is displayed on list pane 50 col. 3, lines 60 to col. 4, lines 7, and col. 4, lines 33-56. See fig. 3 and col. 5, lines 1-54].

As per claims 12 and 19, these claims have similar limitations as claim 5 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 5 above.

As per claim 13 and 20, Bailey et al teach the invention, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al USPN (5835084) in view of Kudoh et al USPN (5948058).

As per claims 7, 14 and 21, although Bailey et al shows substantial features of the claimed invention including a message window with icon buttons enabling a user to store, reply, forward and print message, he does not explicitly show deleting message list on the basis of a request for an end (end command) for reading an electronic mail. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Bailey et al, as evidenced by Kudoh et al USPN (5948058).

In analogous art, Kudoh et al whose invention is about a system for cataloging and displaying emails, disclose deleting a message list (category of a classified electronic mail) on the basis of a request for an end of reading the electronic mail by a user [Col. 28, lines 48 to col. 29, line 13]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Bailey to support mechanism of deleting a list of electronic mails for the flexibility of displaying electronic messages on a desktop and the advantage of improving storage space.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153

Y. B. Sanzelle  
